

REMARKS

The Pending Claims

Claims 20-38 are pending in the application. The pending claims are directed to methods for the preparation of a relief image.

The Amendments to the Specification

The specification has been amended to correct informalities cited by the Office. No new matter has been introduced by way of these amendments.

The Amendments to the Claims

The claims have been amended to so as to more particularly point out and distinctly claim the subject matter of the invention. Claim 20 has been amended to move the recitation of "on-site" from the preamble to the body of the claim and, more particularly, to recite that steps (a) and (b) are performed on-site within a period of less than 2 months. In addition, in step (a) of claim 20, the claim now recites that the material consists essentially of the claimed components, as well as an optional release layer. Support for the amendments can be found at, *e.g.*, page 5, line 36 to page 6, line 4. No new matter has been introduced by way of these amendments.

Summary of the Office Action

The specification is objected to for informalities. Claim 20 stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. The Office has rejected claims 20, 21, 27-33 and 35-37 under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent No. 5,262,275 (Fan) in view of U.S. Patent No. 6,143,470 (Nguyen et al.). Claim 20 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Nguyen et al. in view of Fan. Claims 22-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fan in view of Nguyen et al. in further view of U.S. Patent No. 5,888,712 (Lelental et al.).

Response to Objection to the Specification

In view of the amendment to the specification, the objection is considered moot. Withdrawal of this objection is respectfully requested.

Response to Rejection Under 35 U.S.C. § 112, second paragraph

In view of the amendments to claim 20, the rejection under 35 U.S.C. § 112, second paragraph is considered moot. Withdrawal of this rejection is respectfully requested.

Response to Rejections Under 35 U.S.C. § 103

The rejections under 35 U.S.C. § 103(a) of the pending claims predicated on Fan and Nguyen et al., should be withdrawn in view of the amendments to claim 20 set forth herein and the following comments.

The Office alleges that Fan discloses the lamination of a barrier layer and an infrared sensitive imaging layer onto a UV-sensitive photo-polymerizable layer and that a peelable top layer is optionally included, but that Fan does not teach a distinct adhesive layer between the image receiving layer and the UV-sensitive layer. (Office Action, pages 3-4). Further, the Office alleges that Nguyen et al. provides the lamination of an image receiving layer and an adhesive layer onto a UV-sensitive on a support. (Office Action, page 4).

The Office incorrectly combines the teachings of the two references. The image receiving layer and adhesive layer disclosed in Nguyen et al. are provided at *opposite sides* of a support (*see, e.g.*, Nguyen et al., Fig. 3). As such, combining the teachings of the two patents, all that is provided by Fan and Nguyen et al. is a material with layers in the following order:

Image Recording Layer

Support

Adhesive Layer

UV-Sensitive Layer

Support

Neither Fan nor Nguyen et al. provide any teaching or suggestion as to any other order in which the layers may occur.

The Office alleges that the presence of an intermediate support in the prior art is irrelevant, arguing that it is not critical to the teachings of the reference. (Office Action, page 8). However, to ignore these express teachings in Fan and Nguyen et al. would be

tantamount to picking and choosing among various teachings in a reference *without regard to context*. The fact that the various elements are disclosed in various references is *not sufficient*, in and of itself, to render a claim obvious, and, therefore, unpatentable. Rather, there must be some motivation in the art to make the claimed combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); MPEP 2143.01 ("The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination"). Quite simply, neither Fan nor Nguyen et al. discloses a material wherein an adhesive layer is *in direct contact* with the image recording layer. Nor is there any teaching or suggestion in Fan or Nguyen et al., which would motivate one skilled in the art to deviate from the express teachings contained therein and modify the order in which the layers of the prior art materials are assembled. Put another way, neither Fan nor Nguyen et al. (or the combination of the two references), can be said to teach or fairly suggest a material *consisting essentially of, in the order given*, a support an optional release layer, an image recording layer, and an adhesive layer which can be laminated onto an UV-sensitive layer as recited in the pending claims.

Furthermore, Nguyen et al. employs a *tough* polymeric film (*see* Nguyen et al., col. 8, lines 64-65), such as Mylar, polypropylene, polyethylene or polyethylene terephthalate (*see* Nguyen et al., figure 3, and col. 8, lines 51-52) as a support. The polymeric film is *essential* to the Nguyen et al. invention inasmuch as a support layer is required to support the non-self-supporting photosensitive layer. These tough polymeric films would be rigid, and would resist bending. As such, they would not be useful in practicing a preferred embodiment of the present invention, e.g., where the material would be bent around a cylindrical drum (*see, e.g.*, Application, page 10, lines 23-24). As such, the prior art materials would be useful only for the relatively uncommon flatbed image recorders, and not for drum recorders.

Applicants acknowledge that the intermediate support of Nguyen et al. also solves the problem of monomer diffusion between the UV-sensitive photopolymer layer and the image-recorder layer, although, as described above, it renders the material unsuitable for drum recording. However, in the present invention, the monomer diffusion problem is solved by two aspects: (1) the lamination of both layers *on site* (thus avoiding the need for a barrier layer because the contact time between the UV-sensitive layer and the image recording layer is reduced) and (2) laminating a material *consisting essentially of, in the order given*, a support, an optional release layer, an image recording layer and an adhesive layer onto the

UV-sensitive layer wherein the support can be peeled away before exposure on a drum recorder.

Fan and Nguyen et al., *even in combination*, fail to teach or fairly suggest all of the claim elements as described above. As such, Fan and Nguyen et al. cannot be said to make obvious, and, therefore, render unpatentable, the present invention as recited in the pending claims.

The secondary reference (*i.e.*, Lelental et al.) fails to cure the deficiencies of Fan and Nguyen et al. to teach or fairly describe every element of the invention as claimed. As such, even in view of Lelental et al., the Fan and Nguyen et al. references do not render the present invention unpatentable under 35 U.S.C. § 103(a).

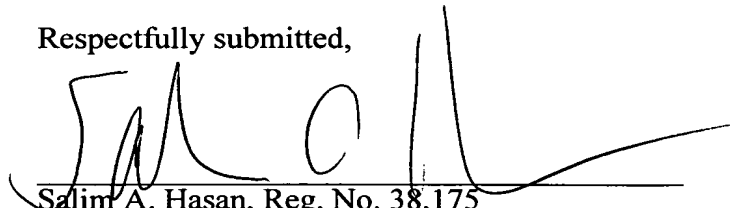
Accordingly, the rejection of the pending claims over the cited art should be withdrawn.

In re Appln. of Daems et al.
Application No. 09/832,660

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Salim A. Hasan', is written over a horizontal line.

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Date: December 18, 2003